

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the following remarks.

I. SUMMARY OF OFFICE ACTION

The Office Action consists of a requirement for restriction under 35 U.S.C. § 121.

The Examiner has divided the claims in the present application as follows:

Species 1 – drawn to an applicator device for applying a substance having a foil barrier;

Species 2 – drawn to a device for applying a substance having a plastic plug barrier that is pierce-able by a piercing element;

Species 3 – drawn to a device for applying a viscous substance;

Species 4 – drawn to a device for applying a powder substance; and

Species 5 – drawn to an applicator device having a cotton applicator head and a tubular grasping section.

The Examiner is requiring an election of one species and a listing of all claims readable on the elected species.

II. RESPONSE TO RESTRICTION REQUIREMENT

The Examiner's Requirement for Restriction is traversed.

The Examiner has required restriction on the basis that the claims define five patentably distinct species. It is submitted respectively that the Examiner's Requirement is deficient on its face because 35 U.S.C. § 121 requires that the involved inventions also be independent.

Clearly the inventions of Species 1 and 2 are not independent. The fact that a different material can be used to form the barrier does not alter the basic invention of an apparatus that delivers a substance.

For example, a sewing machine is not reclassified into different species because its operator can sew cloth, leather, nylon, Kevlar®, etc. Each of the materials may require a different needle, and different thread (type, thickness, etc.), and are not useable together, but the basic configuration of the sewing machine is unchanged.

In addition, the applicator device of Species 1 or Species 2 does not depend on the type of substance being applied. That is, the substance can be a cream, liquid, powder, etc. as long as it has viscous properties.

Species 3 and 4 are not independent since a "viscous" substance is one that can flow. Accordingly, a powder under Species 4 is a viscous substance and is not independent of Species 3.

The only possible arguments the Examiner can make for issuing a Restriction Requirement is that claim 1 does not specifically recite a tubular grasping section, while claim 18 does. Even then this is a weak argument since it would be clear to a person skilled in the art, after reading the Applicant's disclosure, that a person must handle the applicator device of claim

1 in order to apply the substance. Accordingly, the Examiner's Requirement for Restriction should be withdrawn.

In response to the Restriction Requirement, Applicant provisionally elects Species 3 including Claims 1 - 17 and 19. If the Examiner refuses to withdraw the Restriction Requirement, Applicant reserves its right to file a divisional application having claims directed to any withdrawn claims.

No amendments to the claims were made to traverse a rejection based on art.

III. CONCLUSION

Applicant elects provisionally to prosecute the claims of Species 3, that is claims 1 - 17 and 19.

If the Examiner refuses to withdraw the restriction requirement, Applicant cancels without prejudice claim 18. Further, Applicant reserves the right to pursue, in a divisional and/or continuation application, claims that are the same or of similar scope as those the Examiner believes are classified in a different Species.

Applicant believes he has addressed all issues raised by the Examiner in the outstanding Restriction Requirement. Accordingly, Applicant respectfully requests the early issuance of Claims 1 - 19.

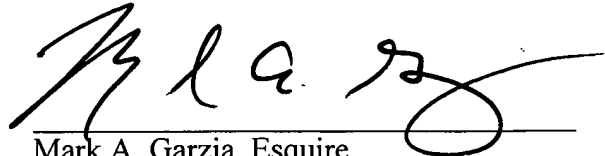
Enclosed is a postage-prepaid, self-addressed postcard for the PTO to acknowledge receipt of this communication.

Should the Examiner have any questions regarding this reply, she is invited to telephone the undersigned in order to expedite the prosecution of the present application.

Respectfully submitted,

Kenneth A. Alley

Date: 7 JULY 2006



Mark A. Garzia, Esquire
Registration No. 35,517
Attorney for Applicant

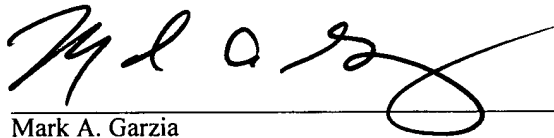
Law Offices of Mark A. Garzia
2058 Chichester Ave.
Boothwyn, PA 19061
Telephone: (610) 485-9400

* * * * *

CERTIFICATE OF MAILING

I hereby certify that this communication, along with any paper or fee indicated as being enclosed, are being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to: Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

7 JULY 2006
Date


Mark A. Garzia